



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,040	12/15/1999	Michelle Q. Wang Baldonado	104323	3267

7590

11/04/2003

Oliff & Berridge PLC
PO Box 19928
Alexandria, VA 22320

EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,040

Applicant(s)

BALDONADO ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Request for Reconsideration filed 09/15/2003 to the original application filed 12/15/1999.
2. Claims 1-37 are currently pending in this application. Claims 1, 14 and 26 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eberman et al.** (U.S. 6,173,287 – filed 03/1998) in view of **Schilit et al.** “Beyond Paper: Supporting Active Reading with Free Form Digital Ink Annotations”, (Public Release 04/1998 - cited by IDS, paper #2).

As to independent claim 14, Eberman discloses a method for associating annotations with at least one object (*an annotation of interest corresponding to the item of interest; col.2, lines 16-24*) comprising:

- searching for the at least one object to annotate (*Once the annotation of interest has been found; col.2, lines 46-59*);

- obtaining an object identifier for at least one object (*each object in the meta database ...along with ,or with reference to, each associated object identification number; col.20, lines 61-65 /obtains the object identification number ... object type; col.21, lines 15-29*).

- generating at least one annotation using an annotation device (*the annotation client ...generate annotations for the object; col.7, lines 19-52*);

- associating the at least one annotation with at least one portion of the object (*Fig. 7*);

- associating the at least one annotation with the at least one object identifier (*Each annotation has an associated search identifier ...an object identification number; col.2, lines 39-45 / the search identifier can be, for example, stored with, or referenced to, the annotation of interest ...the search identifier is preferably an object identifier; col.3, lines 9-33*).

Eberman does teach displaying the at least one object and the at least one annotation with viewing device (*Figs. 12-14*), but is silent on “displaying the at least one object and the at least one annotation with viewing device that distinct from the annotation device.”

Schilit discloses displaying the at least one object and the at least one annotation with viewing device that distinct from the annotation device (*Readers use these marks to organize their reading for later review and retrieval; page 1, the right hand column, the second paragraph*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schilit with Eberman because it would have

provided the capability for allowing the users to create and view the annotations in different media.

As to dependent claim 15, Eberman discloses the annotation linking circuit establishes the link to the at least one portion based on at least one of a graphical technique and a textual technique (*col.2, lines 24-38*).

As to dependent claim 16, Eberman discloses the graphical technique associates the at least one annotation with at least one portion of the at least one object based on selection of at least one portion of a graphical icon that is a visual surrogate of the at least one object (*col.2, lines 24-38*).

As to dependent claim 17, Eberman discloses the textual technique comprises associating the at least one annotation and at least one of a word, phrase or a portion of text (*col.2, lines 24-38*).

As to dependent claim 18, Eberman discloses the textual technique is based on a phrase completion technique.

As to dependent claim 19, Eberman discloses associating the object identifier and the at least one object (*col.2, lines 16-45*).

As to dependent claim 20, Eberman discloses retrieving supplemental information associated with the at least one object.

As to dependent claim 21, Eberman discloses developing a digital surrogate of the at least one object (*col.2, lines 16-45*).

As to dependent claim 22, Eberman discloses retrieving at least one previous annotation associated with the at least one object (*col.3, lines 9-34*).

As to dependent claim 23, Eberman discloses annotating at least one of the at least one previous annotation (*col.3, lines 9-34*).

As to dependent claim 24, Eberman discloses searching for the at least one object comprises: entering at least one of a description of the object and the object identifier; and searching at least one of a networked search engine, a personal computer and a distributed network (*col.2, line 24- col.3, line 34 & col.4, lines 44-65*).

As to dependent claim 25, Eberman discloses the at least one object is at least one of a media type object, a device type object, a location type object and a digital document (*Figs. 8-9*).

Independent claim 26 is directed to an information storage media for implementing the method of claim 14, and is similarly rejected under the same rationale.

Dependent claims 27-30 and 31-37 include the same limitations as in claims **15-18** and **20-25**, and are similarly rejected under the same rationale.

As to independent claim 1, the rejection of claim 14 above is incorporated herein in full. However, claim 1 further recites:

- an input device that receives at least one annotation; and
- a database that stores an object identifier, the at least one annotation and the link.

Eberman discloses:

- an input device that receives at least one annotation (*an annotation of interest corresponding to the item of interest; col.2, lines 16-23*);
- a database (*a database; col.2, lines 39-59*) that stores an object identifier (*an object identification number; col.2, lines 39-59*), the at least one annotation and the link.

Application/Control Number: 09/461,040
Art Unit: 2176

Dependent claims 2-5 include the same limitations as in claims 15-18, and are similarly rejected under the same rationale.

As to dependent claim 6, Eberman discloses the search circuit is located in at least one of the annotation device, a personal computer and a networked search engine (*col. 4, lines 44-65*).

As to dependent claim 7, Eberman discloses the search circuit receives at least one of the object identifier and one or more key words corresponding to the object to be annotated (*col.2, line 25- col.3, line 34*).

As to dependent claim 8, Eberman discloses an annotation database that stores the at least one annotation and the object identifier for the at least one object (*col.2, lines 16-45*).

As to dependent claim 9, Eberman discloses the annotation database is located on a distributed network (*Figs. 1A&1B*).

As to dependent claim 10, Eberman discloses the annotation database stores at least one annotation previously associated with the at least one object (*col.7, lines 19-67*).

Dependent claim 11 includes the same limitations as in claim 25, and is similarly rejected under the same rationale.

As to dependent claim 12, Eberman does not explicitly disclose the annotation device is a portable device.

Schilit discloses the annotation device is a portable device (*Fig.1*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Schilit with Eberman because it would have

provided the capability for allowing the users to create and view the annotations in different media.

As to dependent claim 13, Eberman discloses the object identifier is collocated with the at least one object (*col.2, line 39- col.3, line 34*).

Response to Arguments

4. Applicant's arguments with respect to claims 1-37 have been considered but they are not persuasive.

In response, the Examiner believes that the introduction of Eberman, as combined with Schilit meets the limitations as claimed by Applicant.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450


Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.
OFFICIAL faxes must be signed and sent to (703) 872-9306.
NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
October 22, 2003


SANJIV SHAH
PRIMARY EXAMINER